



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,116	07/19/2003	Sumit Agarwal	13914-032001 / 2003P00455	4446
32864	7590	04/23/2008		
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
FADOK, MARK A				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
04/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/623,116

**Applicant(s)**

AGARWAL, SUMIT

**Examiner**

MARK FADOK

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.  
4a) Of the above claim(s) 2-6, 11-16, 18-22, 27-32, 34-38 and 43-48 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 7-10, 17, 23-26, 33 and 39-42 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 19 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-848)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/5/2004.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: t

## **DETAILED ACTION**

### ***Response to Election***

The examiner is in receipt of applicant's response to office action mailed 9/10/2007 which was received 2/12/2008. Acknowledgement is made to the election of Group ID without traverse.

### ***Examiner's Note***

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1,17,33-10,17 are rejected under 35 U.S.C. 102(e) as being anticipated by Scott (US PG PUB 20020198818).**

In regards to claims 1,7-10,17,23-26,33 and 39-42, Scott Discloses a method of electronic commerce, comprising:

receiving dynamic attribute parameters defining a administrator dynamic attribute (buyer preferences and rules, FIG 3),

the dynamic attribute parameters including a name and a data type for the administrator dynamic attribute (para 0036-0038);

receiving a criterion to automatically determine whether to associate the administrator dynamic attribute with a particular opportunity representing a potential commercial transaction. (Scott teaches automatically associating particular opportunities criterion (product selected) associated with a particular commercial transaction (para 0011, based on products selected an RFQ is automatically generated),

subsequently receiving user input to generate a new opportunity, the user input including attribute data for one or more attributes of the new opportunity (product information);

determining whether the new opportunity meets the criterion based on the attribute data; and

automatically associating the administrator dynamic attribute with the new opportunity if the new opportunity meets the criterion (FIG 4, buyer profile and rules are used to automatically associate a dynamic attribute with a product).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 7-10,23-26 and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott in view of Coffman et al (US PG PUB 20040215467).**

**In regards to claim 7**, Scott teaches generating a template for a user to add information (para 0042), but does not specifically mention that a template is returned to enter dynamic attribute data. Coffman teaches providing an alternative webpage to insert additional dynamic data when a default is not selected (in the case of Scott as a preference) para 0081, FIG 8,16 and para 0055). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Scott providing additional screens to accept data when a product selected requires additional information due to a preference other than default, because this provides increased flexibility to organizations that require RFQ creation that is flexible, therefore creating additional customers.

Further, it is noted that all of the elements of the cited references perform the same function when combined as they do in the prior art . Thus such a combination

would have yielded predictable results (see Sakraida, 425 US at 282, 189 USPQ at 453. Since the independent claims only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

**In regards to claim 8**, the combination of Scott and Coffman teach receiving user input to generate a different opportunity prior to receiving the criterion to automatically determine whether to associate the administrator dynamic attribute with a particular opportunity (para 0011, product information and quantity), wherein the user input includes dynamic attribute data for a dynamic attribute to associate with the different opportunity (Coffman FIG 8 and 16).

**In regards to claim 9**, the combination of Scott and Coffman teach transmitting opportunity data for the different opportunity to one or more potential suppliers (FIG 4); and

subsequent to receiving the criterion to automatically determine whether to associate the administrator dynamic attribute with a particular opportunity,

generating a response template to receive user input from a particular potential supplier of the one or more potential suppliers,

the response template including one or more user interfaces to display attribute information pertaining to a response attribute of the one or more attributes, and further to display a response attribute field to receive user input comprising associated response attribute data (Scott, para 0057-0073).

**In regards to claim 10**, the combination of Scott and Coffman teach wherein the attribute information includes attribute information pertaining to the dynamic attribute but not to the administrator dynamic attribute (Scott para 0057-0073, information regarding the dynamic attribute is provided to the merchant, but the merchant does not have the authority to change the dynamic attribute)..

**In regards to claims 17,23-26,33 and 39-42**, these claims are considered to be partalell to the claims above and are therefore rejected for the same rationale.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

Alexandria, Va. 22313-1450

or faxed to:

**571-273-8300** [Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/

Primary Examiner, Art Unit 3625



